



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,143	11/10/2000	William C. Tate	81803F-P	3253

1333 7590 03/09/2004

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,143

Applicant(s)

TATE, WILLIAM C.

Examiner

Marissa Thein

Art Unit

3625

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's "Amendment" deposited on December 15, 2003 has been considered with the following effect.

Claims 1-36 remain pending in this application.

Response to Arguments

Applicant's arguments filed on December 15, 2003 have been fully considered but they are not persuasive.

Applicant's remark that "the Jebens reference does not teach or suggest the invention as set forth in independent claims 14 and 28". Specifically, "there is no teaching or suggesting of sending an email having a static section that is provided with the email and a dynamic section that obtains data only upon opening of the e-mail".

The Examiner notes that Jebens does disclose the recited claims 14 and 28. In col. 14, lines 36-54, Jebens discloses, upon entering the ordering routine, the system will first download a destination and instruction form to the user for completion (sending an email to a receiving site of a customer). After user completes this form by identifying the identity of the user who is to receive the work order and adding any desired instructions for the receiving user, the system will temporarily store the destination and instruction form. The sending user identifies any data files such as high resolution images to be included in the work order. In col. 6, lines 1-6, Jebens discloses a mail server for performing email messaging for effecting communication with the users and the like. In col. 8, lines 23-25, Jebens further discloses a mail database which is used

Art Unit: 3625

to store emails and conventional addresses for user. Such mail server and downloading a destination and instruction form to the user for completion of an order are considered sending email to a receiving site of a customer over the communication network. Furthermore in col. 21, line 61- col. 22, line 11, Jebens discloses the host site downloads a custom email form when the user wishes to place an order. The user will fill in the email form with a short description and instructions for the receiver of the job order. In Figure 10F, Jebens discloses the email that the host site has sent. The email form 820 includes a static area which is the "description" and "instructions" and dynamic area where the customer provides the description and the instructions of the order (See Figure 10F). Moreover, the user can add images by selecting one or more images from the lists to be included in the order (col. 22, lines 2-6). Such downloading of the email form when the user wishes to place an order and with the user filling out the form by providing description and instruction for ordering are considered the sending an email to a customer, the email having a static section and dynamic section that obtains data only upon opening of the email, and the static text and/or graphics containing an order section for ordering of goods and/or services with respect to the dynamic data.

Applicant's recitations in claims 14 and 28 "read on" this disclosure.

Applicant's remark that "Williams reference does not disclose or teach anything that would render the independent claims obvious". Specifically, Williams does not teach or suggest the providing of the email having both the static and dynamic sections wherein the static section is first sent to the recipient and later the information for the

Art Unit: 3625

dynamic section is sent only upon opening of the email", as pertaining to claims 1-13, 17, 27, and 30-36.

The Examiner notes that Williams was cited for teaching the emailing of the digital images and the location for receiving the digital image upon opening of the email. Jebens was cited for the providing of the email having both static and dynamic sections the static section is sent to the recipient and later the information for the dynamic section is sent only upon opening of the email. Examiner directs Applicant attention to the Examiner's response to Applicant's previous remarks regarding claim 14 and 28.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-16, 18-26 and 28-29 rejected under 35 U.S.C. 102(e) as being anticipated by Jebens. Regarding claims 14-15 and 28-29, Jebens discloses a method, computer software product, and system for ordering goods and/or services with respect to digital images comprising:

- a server of a first party for sending email to a receiving site of a customer over the communication network (col. 8, lines 23-25; col. 21, lines 63-67; Figures 10F, 10G, and 10I);

Art Unit: 3625

- the email having a static section containing static text and/or graphics (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);
- the email having a dynamic area/section for containing dynamic data, the dynamic data is automatically forwarded to the receiving site only upon opening of the email at the receiving site (col. 21, lines 63-67; Figures 10F, 10G, and 10I);
- the static text/and/or graphics containing an order section for ordering of goods and/or services with respect to the dynamic data (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);
- dynamic data comprises the low-resolution digital image file (col. 8, lines 12-18); and
- a fulfillment provider for filling of the order, the email having information for allowing the automatic forwarding of the order to the fulfillment provider (col. 22, lines 24-92; col. 23, lines 3-18)

Regarding claims 16 and 26, Jebens discloses the static text and/or graphic comprises an order form for placement of an order for goods and/or services with respect to the image (col. 21, lines 62-66; Figure 10F); and Internet (col. 6, lines 1-5).

Regarding claims 18-19 and 21, Jebens discloses the email further includes a URL address of a second party which, upon placing of an order using the order section, will be used to send said order automatically to the second party, the URL address being different from the URL address of the first party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66); the second party will fulfill the order placed by the customer (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66);

Art Unit: 3625

and a notice is sent to the first party by the second party when the order is placed with the second party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66).

Regarding claims 20 and 22, Jebens discloses a portion of the money paid by the customer to the second party is allocated to the first party; and the portion of the money paid to the second party is forwarded to the first party upon or after receipt of payment by the customer to the second party. (Col. 17, line 51 – col. 18, line 27)

Regarding claims 23-25, Jebens discloses the email includes the ability for the customer to send an e-mail to a third party for allowing access to the images at the server and for placement of an order by the third party; the customer further permits the third party to provide additional data to the images; and the server allows the third party to provide data the dynamic data (col. 3, lines 1-10; col. 3, lines 51-65; col. 14, lines 11-54; Claim 35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 17, 27, and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,321,231 to Jebens et al. and further in view of U.S. Patent No. 6,388,732 to Williams et al.

Regarding claims 1-2, 4, and 27, Jebens discloses a method and computer software product for ordering goods and/or services with respect to digital images comprising:

- a server of a first party for sending email to a receiving site of a customer over the communication network (col. 8, lines 23-25; col. 21, lines 63-67; Figures 10F, 10G, and 10I);
- a static section containing static text and/or graphics (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);
- a dynamic area/section for containing dynamic data, the dynamic data is automatically forwarded to the receiving site (col. 21, lines 63-67; Figures 10F, 10G, and 10I); and
- dynamic data comprises the low-resolution digital image file (col. 8, lines 12-18).

However, Jebens does not explicitly disclose the emailing of the digital images and the location for receiving the digital image upon opening of the e-mail. Jebens discloses an image database which is adapted for archiving low and high resolution copies of digital images files (col. 8, lines 12-13). Furthermore, Jebens discloses a work order where a user may select images from a list to be included in a work order (col. 22, lines 1-12). Williams, on the other hand, teaches the emailing of the digital images and the location for receiving the digital image upon opening of the email (col. 1, lines 45-60; col. 2, line 60 – col. 3, line 17).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and product of Jebens, to include

Art Unit: 3625

the emailing of the images and the location, as taught by Williams, in order to provide photographic prints digitally and interactively so as to increase productivity and provide higher quality product to customers (Williams col. 1, lines 32-40).

Regarding claims 3 and 13 (which depends on claim 1), Jebens discloses the static text and/or graphic comprises an order form for placement of an order for goods and/or services with respect to the image (col. 21, lines 62-66; Figure 10F); and Internet (col. 6, lines 1-5).

Regarding claims 5-6 and 8 (which depends on claim 1), Jebens discloses the email further includes a URL address of a second party which, upon placing of an order using the order section, will be used to send said order automatically to the second party, the URL address being different from the URL address of the first party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66); the second party will fulfill the order placed by the customer (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66); and a notice is sent to the first party by the second party when the order is placed with the second party (col. 22, lines 26-35; col. 23, lines 3-18; Figure 10G; col. 22, lines 43-66).

Regarding claims 7 and 9 (which depend on claim 1), Jebens discloses a portion of the money paid by the customer to the second party is allocated to the first party; and the portion of the money paid to the second party is forwarded to the first party upon or after receipt of payment by the customer to the second party. (Col. 17, line 51 – col. 18, line 27)

Art Unit: 3625

Regarding claims 10-12 (which depend on claim 1), Jebens the email includes the ability for the customer to send an e-mail to a third party for allowing access to the images at the server and for placement of an order by the third party; the customer further permits the third party to provide additional data to the images; and the server allows the third party to provide data to the dynamic data (col. 3, lines 1-10; col. 3, lines 51-65; col. 14, lines 11-54; Claim 35).

Regarding claim 17, Jebens substantially discloses the claimed invention, however, it does not explicitly disclose the emailing of the digital images and the location for receiving the digital image upon opening of the e-mail. Jebens discloses an image database which is adapted for archiving low and high resolution copies of digital images files (col. 8, lines 12-13). Furthermore, Jebens discloses a work order where a user may select images from a list to be included in a work order (col. 22, lines 1-12). Williams, on the other hand, teaches the emailing of the digital images and the location for receiving the digital image upon opening of the email (col. 1, lines 45-60; col. 2, line 60 – col. 3, line 17).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and product of Jebens, to include the emailing of the images and the location, as taught by Williams, in order to provide photographic prints digitally and interactively so as to increase productivity and provide higher quality product to customers (Williams col. 1, lines 32-40).

Regarding claim 30, Jebens discloses a system for ordering goods and/or services with respect to digital images comprising:

Art Unit: 3625

- a retailer (image providers) for receiving an image product (col. 6, lines 55-60);
- a server of a first party for sending email to a receiving site of a customer over the communication network (col. 8, lines 23-25; col. 21, lines 63-67; Figures 10F, 10G, and 10I);
- a static section containing static text and/or graphics (col. 21, lines 63-67; Figures 10F, ref. no. 820; Figure 10G; and Figure 10I ref. no. 860);
- a dynamic area/section for containing dynamic data, the dynamic data is automatically forwarded to the receiving site (col. 21, lines 63-67; Figures 10F, 10G, and 10I); and
- a fulfillment provider for filling the order, the email having information for allowing the automatic forwarding of the order to the fulfillment.

However, Jebens does not explicitly disclose the emailing of the digital images and the location for receiving the digital image upon opening of the e-mail. Jebens discloses an image database which is adapted for archiving low and high resolution copies of digital images files (col. 8, lines 12-13). Furthermore, Jebens discloses a work order where a user may select images from a list to be included in a work order (col. 22, lines 1-12). Williams, on the other hand, teaches the emailing of the digital images and the location for receiving the digital image upon opening of the email (col. 1, lines 45-60; col. 2, line 60 – col. 3, line 17).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method and product of Jebens, to include the emailing of the images and the location, as taught by Williams, in order to provide

Art Unit: 3625

photographic prints digitally and interactively so as to increase productivity and provide higher quality product to customers (Williams col. 1, lines 32-40).

Regarding claims 31-33, Jebens disclose the server is remote from the retailer (Figures 1-2; col. 6, lines 52 – col. 7, line 20); the fulfillment provider is remote from the retailer (Figures 1-2; col. 6, lines 52 – col. 7, line 20); and the fulfillment provider is remote from the server (Figures 1-2; col. 6, lines 52 – col. 7, line 20).

Regarding claims 34-36, Jebens discloses the fulfillment provider pays the retailer a portion of payment received from the customer for the order; the fulfillment provider receives orders from a plurality of retailers, where means are provided for keeping track of which of the plurality retailers forwards which of the orders to the fulfillment provider; and keeping track when the customer pays the fulfillment provider hand forwarding a portion of payment received from the customer to the retailer that sent the order to the fulfillment provider (col. 17, line 51 – col. 18, line 28).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3625

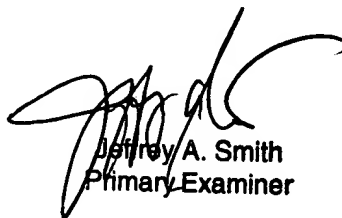
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
March 4, 2004



Jeffrey A. Smith
Primary Examiner